

REMARKS

A. Introduction

Claims 1-18 were presented for examination

Claims 1-18 were rejected.

B. Claim Rejections Under 35 U.S.C. § 102

Examiner rejected Claims 1, 16 and 18 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 6,458,388 to Genis et al (Genis). Applicant respectfully disagrees.

A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); Manual of Patent Examining Procedures (M.P.E.P.) § 2131.

Examiner states that Genis discloses a composition comprising Dead Sea salt granules, having particle size of 0.1-0.3 mm, which is less than the claimed size. Examiner simply misinterprets Genis. Although the particle size is less than the claimed size, the salts used in the Genis reference are preferably sodium chloride or potassium chloride (col. 2, lines 60-61). In other words, Genis does not disclose Dead Sea salts in granule form, but simply an added ingredient to the composition. This is further evidenced by Genis disclosing that the “cream also contains mixture of mineral salt.” (col. 2, lines 63-64). Further, Genis discloses that the aqueous solution contains a “combination of dead sea salts as mineral solutes.” (col. 2 lines 48-51).

Genis gives two examples of the consistency of the cosmetic cream. In its first example, the salt granules are either potassium chloride or sodium chloride, not Dead Sea

salt granules. In the second example, the salt is *exclusively* potassium chloride. Therefore, the 0.1-0.3 mm particle sizes of the salt granules referred to in the Genis reference are either sodium chloride or potassium chloride, but not Dead Sea salts. To be sure, the Dead Sea minerals of the present invention simply cannot be fractionalized further without the addition of artificial ingredients. Moreover, Genis fails to disclose that the Dead Sea salts are processed into ultra fine particles prior to their use in the composition. Thus, Genis fails to disclose “a mixture of at least 50% of the processed Dead Sea mineral particles” as recited in Claim 1.

Examiner interprets the limitation of Claim 1 of “at least 50% of the processed Dead Sea mineral particles” as out of the total amount of Dead Sea minerals in the cosmetic composition, at least 50% of the minerals are processed and in the form of particles. Examiner interprets incorrectly.

In the present invention, all Dead Sea minerals in the composition are processed. The correct interpretation is that the Dead Sea minerals make up at least 50% of the total composition. This was expressly indicated in the specification disclosing that the final composition was approximately 51% ultra fine Dead Sea minerals, 25% palm oil, 9.0% soybean oil, 5.0% olive oil, 3.0% jojoba oil, 3.0% beeswax, 1.0% essential oil blend, 1.0% jojoba wax PEG 120, 1.0% cashew husk oil ethoxylate, 1.0% coconut oil, 0.1% natural source Vitamin E oil or d alpha tocopherol, 0.5% Vitamin E or natural mixed tocopherols. (Specification page 19, line 21 through page 20, line 5). If all the percentages are added up, they total 100.6%.

Clearly, Applicant’s description of “approximately 51% ultra fine Dead Sea minerals” is of the entire composition, not just the ultra fine Dead Sea minerals making

up part of the entire Dead Sea minerals. Genis, on the other hand, limits its contents of the Dead Sea salts as mineral solutes in the aqueous solution, comprising approximately 5.86% of the cosmetic cream. (col. 4, table 2).

As previously shown, the Dead Sea minerals contained in Genis are in an aqueous solution and therefore not in granule form. Therefore, Genis also fails to show “processed Dead Sea particles are less than about 10 mesh and less than about 1.0 mm size granularity” as recited in Claim 16.

Examiner states that the particles of Genis have the same size as claimed and hence meet “the processed” limitation of the present invention. Once again it is pointed out that granularity sizes in Genis referred either to sodium chloride or potassium chloride, but not Dead Sea salts. Moreover, the Dead Sea minerals of the present invention cannot be further broken down into smaller particles, as doing so would require the addition of artificial ingredients rendering the composition unnatural. Therefore, Genis also fails to disclose “100% of said processed Dead Sea minerals comprising granularity of less than about 10 mesh and less than about 1.0 mm size granularity” as recited in Claim 18.

Examiner states that Genis discloses Dead Sea particles of same particle size and in a cosmetic medium containing Vitamin E, and thus the property of not settling out of carrier medium is inherent to the composition of Genis. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); M.P.E.P. § 2112.

First, as previously noted, Genis does not contain Dead Sea salt granules.

Second, although the carrier medium in the invention contains Vitamin E, Examiner implies that Vitamin E is the sole basis of why the property of not settling out of the carrier medium is inherent to the composition of Genis. The present invention contains many more constituents other than Vitamin E. The Dead Sea mineral composition of the present invention also contains palm oil, soybean oil, olive oil, jojoba oil, beeswax, essential oil blend, jojoba wax PEG 120, cashew husk oil ethoxylate, and coconut oil.

Examiner failed to provide a basis in fact and/or technical reasoning to reasonable support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Genis. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)(emphasis in original); M.P.E.P. § 2112. Therefore, the property of not settling out of “carrier medium” cannot be attributed solely to Vitamin E. Thus, Genis fails to disclose the limitation of Claim 1 that “Dead Sea mineral particles do not rapidly settle out of said carrier medium.”

Examiner states that the instant claims do not state if 50% is pertaining to the concentration of Dead Sea salts in the composition, but that Genis discloses Dead Sea salts in the composition in an amount of 5 to 40 parts and thus anticipates the instant claims. Applicant respectfully disagrees.

As previously demonstrated above, the specification of the instant invention expressly states that the 50% is pertaining to the total concentration of Dead Sea salt in the composition. Contrary to Examiner’s assertion, Genis does not disclose Dead Sea salts in the composition in the amount of 5 to 40 parts. The “5 to 40 parts” referenced in Genis refers to a mixture of: (1) mineral salts which are dissolved in the aqueous solution; (2) dissolved sodium chloride and potassium chloride, and (3) solid granular

sodium chloride and/or potassium chloride.

The Genis reference simply does not disclose “a mixture of at least 50% of the processed Dead Sea mineral particles in a continuous all-natural carrier medium wherein said Dead Sea mineral particles do not rapidly settle out of said carrier medium” as recited in Claim 1. Genis also fails to disclose “processed Dead Sea particles are less than about 10 mesh and less than about 1.0 mm size granularity” as recited in Claim 16. Finally, Genis fails to disclose “[p]rocessed Dead Sea minerals, 100% of said processed Dead Sea minerals comprising granularity of less than about 10 mesh and less than about 1.0 mm size granularity” as recited in Claim 18. Thus, Genis simply does not anticipate Claims 1, 16, 18.

C. Claims 11, 12, 14, and 15 Rejected Under 35 U.S.C. § 103

Examiner rejects Claims 11, 12, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,458,388 to Genis et al (Genis) in view of EP 1074245 (EP ‘245). Applicant respectfully disagrees.

Examiner bears the initial burden of establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be some reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not be based on applicant’s disclosure. Manual of Patent

Examining Procedure (M.P.E.P. § 2142); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Examiner failed to establish a *prima facie* case of obviousness.

1. Teaching or Suggestion of All Claim Limitations

To establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1296 (Fed. Cir. 1988); M.P.E.P. § 2143.03. The prior art references do not teach or suggest all of the claim limitations.

As previously noted, the Genis reference does not teach or suggest any of the claim limitations of Claims 1 and 16. Applicant respectfully reasserts those arguments made above. Further, Genis fails to cite the limitation of “an essential oil blend” as in Claim 11. In fact, Genis does not teach “essential oil blend comprises lavender” as in Claim 12, “essential oil blend comprises chamomile” as recited in Claim 14, or “essential oil blend comprises calendula” as recited in Claim 15. These claim limitations are simply not found in the Genis reference.

Examiner cites the EP ‘245 reference as containing 5% Dead Sea salts and other herbs and aromatic essences such as lavender, chamomile, and calendula. However, while EP ‘245 does contain some Dead Sea salts, EP ‘245 fails to teach the limitation of “an essential oil blend” as recited in Claim 11. EP ‘245 does disclose lavender as an aromatic essence, however, it is coupled with geranium for PMS relief. (Table on page 9 continuing to page 10). Lavender is also coupled with Orange Blossom and Vetivyr for total relaxation. (Table on page 9 continuing to page 10). However, lavender does not

make up a component of “an essential oil blend” as recited in Claim 11. Thus, EP ‘245 fails to teach “essential oil blend comprises lavender” as in Claim 12.

Chamomile is used either as an aromatic essence along with Melissa and Linden, or as an organic herb with calendula and clove. In either form, it is used for skin calming. (Table on page 9 continuing to page 10). However, neither chamomile nor calendula make up a component of “an essential oil blend” as recited in Claim 11. As with lavender, EP ‘245 fails to teach the limitations of “essential oil blend comprises chamomile” as recited in Claim 14, or “essential oil blend comprises calendula” as recited in Claim 15. Like Genis, and contrary to Examiner’s contentions, these limitations are not found in the EP ‘245 reference.

2. Non-Analogous Art

To rely on references under 35 U.S.C. § 103, the references must be analogous prior art. M.P.E.P. § 2141.01(a). In order to rely on a reference as a basis for a rejection of an applicant’s invention, the reference must be either in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992).

Genis teaches a cosmetic composition in an oil and water base where the granules are composed of either sodium chloride or potassium chloride. However, Genis does not include the use of the specific essential oils of the present invention.

EP ‘245 makes no reference to rosewood. Moreover, EP ‘245 uses lavender, chamomile, and calendula separately or with at most one additional aromatic essence of the present invention, *e.g.*, chamomile with calendula. In contrast, the present invention uses lavender, rosewood, chamomile, and calendula together. Each of these oils come

together, maximizing each of their individual therapeutic benefits together in synergistic harmony, to make up the essential oil blend in the present invention.

EP '245 is in a non-oil base and does contain granules which are composed of Dead Sea salts. However, these salts are present only in a quantity sufficient to improve properties of the composition. This "quantity sufficient to improve properties" is between 5 to 10%. In fact, as Examiner pointed out, only 5% of the total composition of EP '245 is attributed to the Dead Sea salts. Clearly, this 10% concentration marks the upper limits of EP '245. Indeed, the prime ingredient of EP '245 is water, not the Dead Sea salts. (Table, page 6; Table, page 7).

In contrast, the present invention comprises an oil-based cosmetic composition, making the composition entirely anhydrous. The present invention also contains at least 50% processed ultra fine Dead Sea mineral particles, which are the primary ingredients.

Examiner stated that the process of preparing the composition of EP '245 was the same as that of the present invention because the present invention *also* described the use of ultra fine Dead Sea salts for a homogenous mixing so as to maintain uniformity of the solid suspension.

Even assuming that "[m]ix well until completely dissolved," the reference of page 7 of EP '245 that Examiner indicates (which is the only mixing done where Dead Sea salts are involved), is the equivalent to homogenous mixing, EP '245 simply does not utilize ultra fine Dead Sea salts with an the essential oil blend of lavender, rosewood, chamomile, and calendula. Therefore, the present invention cannot be considered obvious in light of Genis alone or Genis in view of EP '245.

3. Suggestion to Combine References

There is no suggestion to use cosmetic aroma agents with Dead Sea salts in Genis. There is no suggestion to use cosmetic aroma agents with Dead Sea salts of a concentration of more than 10% in EP '245. There is no suggestion in EP '245 to use cosmetic aroma agents with Dead Sea salts which were processed into ultra fine particles and suspended in an oil based carrier medium. Finally, there is no suggestion to combine lavender, rosewood, chamomile, and calendula into an essential oil blend in either Genis or EP '245.

Therefore, there would not be any reasonable expectation of success to modify or to combine the few cosmetic aroma agents claimed in EP '245 with the composition of Genis to improve properties of the cosmetic and cleansing composition. Such combination would not give the expected result of achieving the desired effects of a significantly high concentration of ultra fine Dead Sea mineral particles suspended in an oil based carrier medium with improved relaxation from the aromatic agents. Examiner improperly rejected Claims 11, 12, 14, and 15.

D. Claims 2-10, 13 and 17 Rejected Under 35 U.S.C. § 103

Examiner rejects Claims 2-10, 13, and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,458,388 to Genis et al (Genis) and EP 1074245 (EP '245) in view of U.S. Patent No. 5,997,889 to Durr et al (Durr). Applicant respectfully disagrees.

1. Teaching or Suggestion of All Claim Limitations

Genis simply does not teach any of the limitations of the dependent claims that Examiner rejected under this section. Specifically, Genis fails to teach or suggest the

“continuous all-natural carrier medium comprises palm oil” recited in Claim 2; “soybean oil” as in Claim 3; “olive oil” as in Claim 4; “jojoba oil” as in Claim 5; “beeswax” as in Claim 6; “jojoba wax” as in Claim 7; “cashew husk oil ethoxylate” as in Claim 8; “coconut oil” as in Claim 9; “Vitamin E oil” as in Claim 10; “essential oil blend comprises rosewood” as in Claim 13; and “essential oil blend comprises lavender, rosewood, chamomile, and calendula” as in Claim 17.

Not only does the primary reference of Genis not show the limitations contained in dependent Claims 2-10, 13 and 17, neither does EP ‘245. Further, although EP ‘245 does disclose lavender, chamomile, and calendula (see discussion above), EP ‘245 does not show that each of the individual essential oils are blended together and thus fails to teach the limitation of “essential oil blend comprises lavender, rosewood, chamomile, and calendula” as in Claim 17.

Like Genis and EP ‘245, Durr fails to teach or suggest the “continuous all-natural carrier medium comprises palm oil” recited in Claim 2; “soybean oil” as in Claim 3; “olive oil” as in Claim 4; “jojoba wax” as in Claim 7; “cashew husk oil ethoxylate” as in Claim 8; and “coconut oil” as in Claim 9. Durr also fails to teach the use of calendula and thus does not include the limitation of “essential oil blend comprises lavender, rosewood, chamomile, and calendula” as recited in Claim 17.

The limitations of the rejected claims are simply not shown in Genis or EP ‘245. Examiner simply fails to cite any reference that includes all of the claimed limitations of the present invention. To combine a third reference now to reject dependent Claims 2-10, 13, and 17 is taking the issue of obviousness to the extreme. Examiner improperly rejected Claims 2-10, 13 and 17.

2. Non-Analogous Art

Both Genis and EP '245 are water based compositions. Durr even teaches that water may be used in the preparation of its composition (col. 4, lines 24-28). This is diametrically opposite to the present invention, which is entirely anhydrous.

The use of Dead Sea Minerals varies dramatically in each cited reference. The Dead Sea salts used in Genis are solutes dissolved in an aqueous solution. EP '245 is silent on the size of the Dead Sea mineral salt granules but also fails to show that any processing is performed on the Dead Sea mineral salts prior to their use in the composition. Finally, Durr does not even contain any Dead Sea mineral salts.

The whole point of the present invention is to dramatically increase the concentration of Dead Sea minerals that can be introduced and remain in a cosmetic composition for ultimate absorption into the human skin. This is not shown in any of the cited references.

3. Suggestion to Combine References

Genis does not suggest the use of ultra fine Dead Sea mineral particles suspended in an all natural carrier medium. Further, EP'245 does not suggest the use of significantly more Dead Sea salts than about 10%, or the use of ultra fine Dead Sea salts, or the use of an oil-based carrier medium. No suggestion exists to significantly increase the amount of Dead Sea salts, process the Dead Sea salts to ultra fine particles, or use an oil based carrier medium in EP '245. There is no suggestion in Durr to combine the fragrances and essential oil with ultra fine Dead Sea mineral particles. Moreover, there is no suggestion to even use Dead Sea salts in Durr.

There is simply no obvious suggestion to combine these references to come up

with the claimed invention, whether using the initial Genis reference cited by the Examiner or ultimately all three references cited by the Examiner. Therefore, there would not be any reasonable expectation of success to modify or to combine the compositions claimed in these prior art references to choose an appropriate oil containing Dead Sea salts so as to provide the desired emolliency of the present invention. To suggest it would be obvious to combine that many references to come up with features that are not even shown in the references stretches obviousness beyond its realistic limits.

Conclusion

In view of the above, the Applicant submits that Claims 1-18 are in condition for allowance. Applicant respectfully requests reconsideration and withdrawal of the rejections. Allowance of Claims 1-18 at an early date is solicited.

If the Examiner still finds impediments to allowance of Claims 1-18 and, in the opinion of the Examiner, a telephone conference between the undersigned and the Examiner would help remove such impediments, the undersigned respectfully requests such a telephone conference.

Respectfully submitted,

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